

REMARKS

The Office Action dated May 16, 2003, has been received and carefully considered. In this response, claims 25-30 have been added, the claims 1, 2, 4-6, 9, 12-16, 18, 22 and 24 have been amended, and claims 3, 7, 8, 10, 11 and 23 have been cancelled without prejudice. Entry of added claims 25-30 and the amendments to claims 1, 2, 4-6, 9, 12-16, 18, 22 and 24 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. THE ANTICIPATION REJECTION OF CLAIMS 1-3, 13, 23 AND 24

On page 2 of the Office Action, claims 1-3, 13, 23 and 24 were rejected under pre-AIPA 35 U.S.C. § 102(e) as being anticipated by Huang (U.S. Patent No. 6,148,072). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S.

International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." Id.

The Examiner asserts that Huang discloses a communication device comprising a first interface to a first channel over a voice network and a second interface to a second channel for transmitting and receiving video data, wherein the communication device is configured to establish a connection to at least a second channel for video conferencing upon receiving a predetermined signal over the first channel.

Applicant respectfully submits that Huang teaches a method and system whereby an analog voice call over a first subscriber line is used to provide information used to establish a digital call over a separate second subscriber line. After the digital call is established, both the voice and video components of the video conferencing session are switched from the analog call of the first subscriber line to the digital call of the second

subscriber line. A second digital call on the first line then may be established to provide additional bandwidth for transmitting both the video and voice components in a digital format (see, e.g., Huang, col. 2, lines 8-25). Huang, however, does not disclose, teach or even suggest the feature of transmitting and receiving the video and voice components via separate channels of a single subscriber line.

Independent claim 23 has been cancelled and independent claims 1 and 24 each have been amended to more clearly recite the feature of transmitting and receiving a voice component and a video component of a video conferencing session via respective voice and data channels of a single subscriber line.

Independent claims 1 and 24 have been further amended to more clearly recite the feature of establishing a connection to the data channel based at least in part on a pre-determined signal received via the voice channel. The amendments to claims 1 and 24 are supported, *inter alia*, in the specification at page 8, line 11 to page 9, line 12, and page 9, line 19 to page 10, line 9. No new matter has been added.

Because amended independent claims 1 and 24 recite features not disclosed by the cited references either alone or in combination, Applicant respectfully submits that independent claims 1 and 24 should be allowable.

Dependent claims 2, 4-6, 9, 12-16, 18 and 22 have been amended to more clearly recite their respective features. The amendments to claims 2, 4, 6, 9, 12-16, 18 and 22 were made solely to improve the form, readability and/or clarity of the claims, and were not made to distinguish the claimed subject matter over the applied documents. Support for the amendments to the dependent claims is provided by the specification and the claims as originally presented. No new matter has been added.

Claims 2, 4-6, 9 and 12-22 are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2, 4-6, 9 and 12-22 should also be allowable at least by virtue of their dependency on independent claim 1.

At this point it should be noted that claims 25, 26 and 30 have been added. New claim 25 has been added to more clearly recite a specific implementation of the pre-determined signal of claim 24. New claim 26 has been added to more clearly recite specific implementations of the voice and data channels of claim 24. New claim 30 has been added to more clearly recite various implementations of the data channel recited in claim 1. Since independent claims 1 and 24 should be allowable as discussed above, new claims 25, 26 and 30 should also be allowable at

least by virtue of their dependency on one of independent claims 1 and 24.

In view of the foregoing, it is respectfully submitted that the aforementioned anticipation rejection of claims 1-3, 13, 23 and 24 is not proper at this time, and the withdrawal of such rejection is respectfully requested.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 4 AND 5

On page 3 of the Office Action, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang (U.S. Patent No. 6,148,072) in view of Bremer et al. (Pub. No. US2001/0022836A1). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v.

Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner asserts that, although not disclosed by Huang, Bremer discloses an apparatus and method for simultaneous multiple telephone type services on a single telephone line and teaches data connections comprising at least one of an asymmetric digital subscriber line (ADSL), a symmetric digital subscriber line (SDSL), a high-data-rate digital subscriber line (HDSL), or a voice-over digital subscriber line (VoDSL). The Examiner therefore concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Huang's system to provide data connections comprising and ADSL, SDSL, HDSL, or VoDSL, as taught by Bremer.

Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness. Huang, as discussed above, discloses the transmission and reception of the voice and video components of a video conferencing session via multiple subscriber lines. Bremer, while disclosing the transmission and reception of multiple telephone services over a single subscriber line, fails to disclose the transmission of

the voice and video components of a video conferencing session via separate channels of the same subscriber line. Instead, with regard to video conferencing, Bremer discloses a "multimedia PC Internet video phone device 51, which captures video and audio and provides the digitized information to modem 50 for transmission to the destination user. The Internet video phone may use either the PSTN or Internet or other land-type network for data communications" (Bremer, pg. 3, para. 35) (emphasis added).

Thus, Bremer discloses the transmission and reception of voice content as digital data that is transmitted over a digital data channel along with the digitized video content, whereas amended independent claim 1, from which claims 4 and 5 depend, teaches the transmission and reception of a voice component via a voice channel separate from the data channel. Accordingly, Bremer fails to disclose the feature of transmitting and receiving a voice component of a video conferencing session via a voice channel of a subscriber line and transmitting and receiving a video component via a data channel of the subscriber line and, therefore, Bremer teaches away from the present invention as claimed.

Thus, because both Huang and Bremer fail to disclose this feature and further because both Huang and Bremer teach away

from this feature, there would be no motivation or suggestion to combine Bremer with Huang to arrive at the present invention as claimed. Accordingly, it is respectfully submitted that the present invention as claimed would not have been obvious over Huang in view of Bremer.

Furthermore, since independent claim 1 should be allowable as discussed above, claims 4 and 5 should also be allowable at least by virtue of their dependency on independent claim 1.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claims 4 and 5 is improper, and the withdrawal of such rejection is respectfully requested.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 6-11

On page 4 of the Office Action, claims 6-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang (U.S. Patent No. 6,148,072) in view of Mihara (U.S. Patent No. 6,323,892). This rejection is hereby respectfully traversed.

The Examiner asserts that although Huang does not explicitly disclose a CCD camera and LCD integrated with a communication device, Mihara discloses the feature of a CCD camera and LCD integrated with a communication device and,

therefore, it would have been obvious to one skilled in the art to combine Huang and Mihara to arrive at the present invention.

Dependent claims 7, 8, 10 and 11 have been canceled. Claim 6 has been amended to more clearly recite the feature of a charge coupled device configured to capture a video component transmitted via the second channel. Claim 9 has been amended to more clearly recite the feature of a liquid crystal display for displaying a video component received via a data channel. Independent claim 1, from which claims 6 and 9 depend, has been amended to more clearly recite the feature of transmitting and receiving a voice component of a video conferencing session via a voice channel of a subscriber line and transmitting and receiving a video component via a data channel of the subscriber line. As noted above, this feature is not disclosed by any of the cited references, including Huang and Mihara. Accordingly, because Huang, Mihara and the other cited references do not claim, disclose or even suggest, alone or in combination, the claimed features of independent claim 1, claims 6 and 9 should be allowable at least by virtue of its dependency on independent claim 1.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claims 6-11 is not

proper at this time, and the withdrawal of such rejection is respectfully requested.

IV. THE OBVIOUSNESS REJECTION OF CLAIM 12

On page 5 of the Office Action, claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang (U.S. Patent No. 6,148,072) in view of Mihara (U.S. Patent No. 6,323,892) and further in view of Haegebath (Japan Pub. No. 02000092463A). This rejection is hereby respectfully traversed.

The Examiner asserts that although Huang and Mihara do not disclose the feature of displaying advertisements, Haegebath discloses the display of advertisements transmitted via a second channel when a first channel is not transmitting or receiving voice. The Examiner therefore concludes that it would have been obvious to one skilled in the art to combine Huang, Mihara and Haegebath to arrive at the features recited by claim 12.

Independent claim 1, from which claim 12 depends, has been amended to more clearly recite the feature of transmitting and receiving a voice component of a video conferencing session via a voice channel of a subscriber line and transmitting and receiving a video component via a data channel of the subscriber line. As noted above, this feature is not disclosed by any of the cited references, including Huang, Mihara and Haegebath.

Accordingly, because Huang, Mihara, Haegebath and the other cited references do not claim, disclose or even suggest, alone or in combination, the claimed features of independent claim 1, claim 12 should be allowable at least by virtue of its dependency on independent claim 1.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claim 12 is not proper at this time, and the withdrawal of such rejection is respectfully requested.

V. THE OBVIOUSNESS REJECTION OF CLAIMS 14-18

On page 6 of the Office Action, claims 14-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang (U.S. Patent No. 6,148,072) in view of Bremer et al. (Pub. No. US2001/0022836A1) and further in view of Fan (U.S. Patent No. 6,519,250). This rejection is hereby respectfully traversed.

The Examiner asserts that it would have been obvious to one skilled in the art to combine Huang's system with the disclosure of Bremer and Fan to provide for fields in a sent packet such as a repeating sequence of characters for synchronization, header information, and an Internet Protocol address of a second communication device, as respectively recited by claims 14-17 as

originally presented. Regarding claim 18, the Examiner asserts that Huang teaches an analog modem to receive a tone burst.

Independent claim 1, from which claims 14-18 depend, has been amended to more clearly recite the feature of transmitting and receiving a voice component of a video conferencing session via a voice channel of a subscriber line and transmitting and receiving a video component via a data channel of the subscriber line. As noted above, this feature is not disclosed by any of the cited references, including Huang, Bremer and Fan. Accordingly, because Huang, Bremer, Fan and the other cited references do not claim, disclose or even suggest, alone or in combination, the claimed features of independent claim 1, claims 14-18 should be allowable at least by virtue of its dependency on independent claim 1.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claims 14-18 is not proper at this time, and the withdrawal of such rejection is respectfully requested.

VI. OBJECTION TO CLAIMS 19-22

Applicant notes with appreciation the indication on page 8 of the Office Action that claims 19-22 would be allowable if rewritten in independent form including all of the limitations

of the base claim and any intervening claims. New claim 27 recites the features of claims 1, 13, 18 and 19 as originally presented. New claim 27 does not recite the additional features of the intervening claims 14-17 as originally presented. However, Applicant respectfully submits that the cited references do not claim, disclose or even suggest, alone or in combination, the claimed features of new independent claim 27. Accordingly, new claim 27 should be allowable even though the additional limitations of claims 14-17 as originally presented are absent from new claim 27. Additionally, new claims 28 and 29 should be allowable at least by virtue of their dependency on new independent claim 27. Acknowledgment of same is respectfully requested.

VII. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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APPENDIX A

AI

1. (Currently Amended) A communications device, comprising:
a first interface to a ~~first~~voice channel of a subscriber line for transmitting and receiving a voice component of a video conferencing session~~over a voice network~~;
a second interface to a ~~second~~data channel of the subscriber line for transmitting and receiving a video datacomponent of the video conferencing session;
wherein the communications device is configured to establish a connection to at least the ~~data~~second channel ~~for videoconferencing upon receiving~~based at least in part on a pre-determined signal received via~~over~~ the ~~first~~voice channel.

2. (Currently Amended) The communications device of claim 1, wherein the ~~voice~~first channel is ~~at~~the public switched telephone network (PSTN).

3. (Cancelled)

4. (Currently Amended) The communications device of claim ~~2~~3, wherein the data ~~channel~~connection comprises at least one of an asymmetric digital subscriber line (ADSL), a symmetric digital subscriber line (SDSL), a high-data-rate digital subscriber line (HDSL), or a voice-over digital subscriber line (VoDSL).

5. (Currently Amended) The communications device of claim 4, ~~wherein the data connection further comprises~~ing a digital subscriber line (DSL) modem.

6. (Currently Amended) The communications device of claim 1, further comprising a charge coupled device (CCD) configured to capture the video component transmitted via the second channel ~~wherein the video data transmitted via the second channel is captured using a charge coupled device camera (CCD) configured for use with the communications device.~~

7. (Canceled)

8. (Canceled)

AI 9. (Currently Amended) The communications device of claim 1, further comprising a liquid crystal display (LCD) for displaying the video component received via the data channel ~~wherein the video data received via the second channel is displayed using a liquid crystal display (LCD) configured for use with the communications device.~~

10. (Canceled)

11. (Canceled)

12. (Currently Amended) The communications device of claim 9, wherein the liquid crystal display (LCD) is used to display advertisements transmitted via the ~~second~~ data channel ~~[[,]]~~ when the ~~first~~ voice channel is not transmitting or receiving voice component.

13. (Currently Amended) The communications device of claim 1, wherein the pre-determined signal is a tone burst comprising a sequence of data ~~that is~~ transmitted from a second

communications device via the voice channel.

14. (Currently Amended) The communications device of claim 13, wherein the sequence of data comprises a first field, the first field comprising an Internet protocol (IP) address of the second communications device ~~a repeating sequence of characters allowing the communications device to synchronize to the tone burst.~~

15. (Currently Amended) The communications device of claim 14, wherein the sequence of data comprises a second field, the second field comprising a repeating sequence of characters allowing the communications device to synchronize to the tone burst ~~header information to identify the second communications device as being a similarly configured communications device.~~

16. (Currently Amended) The communications device of claim 15, wherein the sequence of data comprises a third field, the third field comprising header information to identify the second communications device as being a similarly configured communications device ~~an Internet protocol (IP) address of the second communications device.~~

17. (Original) The communications device of claim 16, wherein the sequence of data comprises a fourth field, the fourth field comprising a checksum character that serves as an error detection mechanism to ensure that the tone burst was transmitted correctly.

18. (Currently Amended) The communications device of claim 13 ~~17~~, further comprising an analog modem to receive the tone burst.

19. (Original) The communications device of claim 18, further comprising a filter to pass the tone burst while excluding any unused frequencies.

20. (Original) The communications device of claim 19, further comprising an analog to digital converter configured to digitize the tone burst.

21. (Original) The communications device of claim 20, wherein the analog to digital converter is a pulse code modulation (PCM) decoder.

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22. (Currently Amended) The communications device of claim 1420, wherein the Internet Protocol (IP) address of the second communications device is ~~extracted from the digitized tone burst~~ and used to establish the second channel ~~for videoconferencing~~.

23. (Canceled)

24. (Currently Amended) A method for establishing a video conferencing session, comprising the steps of:

- a) providing a first interface to a first voice channel of a subscriber line for transmitting and receiving a voice component of the video conferencing session ~~over a voice network~~;
- b) providing a second interface to a ~~second~~ data channel of a subscriber line for transmitting and receiving a video data component of the video conferencing session; and
- c) establishing a connection to at least the ~~second~~ data

channel ~~for videoconferencing upon receiving~~based at least in part on a pre-determined signal received over the firstvoice channel.

25. (New) The method of claim 24, wherein the pre-determined signal is a tone burst comprising a sequence of data-transmitted from a second communications device via the first channel, the sequence of data including a field comprising an Internet Protocol (IP) address of the second communications device.

26. (New) The method of claim 24, wherein the voice channel comprises a public switched telephone network (PSTN) and the data channel comprises at least one of an asymmetric digital subscriber line (ADSL), a symmetric digital subscriber line (SDSL), a high-data-rate digital subscriber line (HDSL), or a voice-over digital subscriber line (VoDSL).

27. (New) A communications device, comprising:
a first interface to a first channel for transmitting and receiving voice signals over a voice network;
a second interface to a second channel for transmitting and receiving video data over a data network;
an analog modem to receive a tone burst, the tone burst comprising a sequence of data transmitted from a second communications device via the first channel;
a filter to pass the tone burst while excluding any unused frequencies;
wherein the communications device is configured to establish a connection to at least the second channel upon receiving the tone burst.

28. (New) The communications device of claim 27, wherein the sequence of data includes a field comprising an Internet Protocol (IP) address of the second communications device.

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29. (New) The communications device of claim 27, wherein the voice channel comprises a public switched telephone network (PSTN) and the data channel comprises at least one of an asymmetric digital subscriber line (ADSL), a symmetric digital subscriber line (SDSL), a high-data-rate digital subscriber line (HDSL), or a voice-over digital subscriber line (VoDSL), a digital T1 line, a digital T3 line, a digital E1 line, a digital E3 line, an Integrated Services Digital Network (ISDN), an Ethernet network, or a synchronous optical network (SONET).

30. (New) The communications device of claim 1, wherein the data channel comprises at least one of an asymmetric digital subscriber line (ADSL), a symmetric digital subscriber line (SDSL), a high-data-rate digital subscriber line (HDSL), or a voice-over digital subscriber line (VoDSL).
